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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,583	11/28/2003	Phillip Borunda	214.01-P-USA	8874
30040	7590	05/10/2006		
MICHAEL A. SHIPPEY, PH. D. 4848 LAKEVIEW AVENUE SUITE B YORBA LINDA, CA 92886			EXAMINER LAUX, JESSICA L	
			ART UNIT	PAPER NUMBER
			3635	

DATE MAILED: 05/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/724,583	BORUNDA, PHILLIP	
	Examiner	Art Unit	
	Jessica Laux	3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-10 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2003 and 30 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/28/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Species I in the reply filed on April 27, 2006 is acknowledged. Claim 4 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 27, 2006.

Claim Objections

Claim 5 is objected to because of the following informalities: The limitation that the top cap is larger in diameter at all points than the body stem by at least 1/8 inch is not supported by the specification or drawings. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 provides for the use of the device of claim 1, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 10 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under

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35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Lewis et al. (5378078).

In regards to claim 1: Lewis et al. discloses a construction hole safety device (10) comprising: a top cap, and underlying body stem fixedly attached thereto (Figure 2), said device made of sturdy, wear-resistant material (Col. 1, lines 33-52), wherein said body stem is capable of fitting within a man-made hole, and is able withstand the weight of people and construction equipment traveling thereon (Col. 2, line 67 – Col. 3, line 8).

In regards to claim 2: The device of claim 1 above, wherein said device is constructed of one piece of material (Figure 2). The limitation “is constructed” is a method step in an article claim and therefore is not given patentable weight. Determination of patentability is based on the product itself. The examiner interprets the claimed limitation to mean that the device is one piece with the stem and cap

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integrally formed. Since the device of Lewis is one piece with the stem and cap integrally formed the claimed limitations are met.

In regards to claim 3: The device of claim 1 above, wherein said device is substantially circular in both top cap and body stem (Figure 1 and Col. 2, lines 8-9).

In regards to claim 6: The device of claim 1, wherein the height of said body stem is precisely the depth of a man-made construction hole (wherein the depth of a man-made construction hole could be any depth depending on the purpose of the hole).

In regards to claim 10: The use of the device of claim 1 to protect construction holes. The device of Lewis is capable of being used to protect construction holes.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 7-8 rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis et al. (5378078).

In regards to claim 5: Lewis et al. discloses a construction safety device as in claim 1 above. Lewis teaches a device with a top cap and a stem where the top extends a distance beyond the stem in all directions (Figure 2) but does not address the dimension of the distance the top extends beyond the stem. Applicant has not disclosed that having the top cap extend at least 1/8 inch beyond the stem solves any

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stated problem or is for any particular purpose. Moreover, it appears that the device of Lewis, or applicants invention, would perform equally well with distance at any dimension beyond the stem. Accordingly, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified Lewis such that the dimension be at least 1/8 inch because such a modification would have been considered a mere design consideration which fails to patentably distinguish over Lewis.

In regards to claim 7: Lewis et al. discloses the device of claim 1 above, but does not disclose that the device is comprised of high-impact polyethylene. Instead Lewis discloses the device is comprised of a series of radially staggered ply layers bonded with resin, wherein the resins combine the best features of polyester and polyurethane technologies. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to use radially staggered ply layers bonded with resin because applicant has not disclosed that spacing high-impact polyethylene provides an advantage, is used for a particular purpose, or solves a stated problem, however applicant does disclose on page 9 of the specification that the device be comprised of sturdy materials to withstand the weight of heavy construction workers walking or standing on it. One of ordinary skill in the art, furthermore, would have expected Lewis's device and applicants invention, to perform equally well with either the ply layers and resin as taught by Lewis or the claimed polyethylene because both would perform the same function of withstanding the weight of heavy construction workers walking or standing on it. Therefore, it would have been

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prima facie obvious to modify Lewis to obtain the invention as specified in claim 7 because such a modification would have been considered a mere design consideration which fails to patentable distinguish over the prior art of Lewis.

In regards to claim 8: The construction device of claim 1, wherein said device meets all pertinent OSHA requirements. It would be obvious to have the device meet all pertinent OSHA requirements if the device is to be used for construction.

Claim 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis et al (5378078) in view of Johnson (5842811).

In regards to claim 9: Lewis et al teaches the device of claim 1 above, but does not teach that the device bears warning labels attached to the top cap such that such labels are clearly visible when the device is in use. Johnson teaches a device having a circular shape and a top used to cover man-made holes. The device has a plurality of warning signs positioned on the upper surface (Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Lewis to have warning signs as taught by Johnson since the signs warn workers of potentially dangerous situations.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Laux whose telephone number is 571-272-8228. The examiner can normally be reached on Monday thru Friday, 8:30am to 4:00pm (est).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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05/08/2006

U. Slack
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Primary